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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	09/834,562	CHEN ET AL.
	Examiner	Art Unit	
	Thuan Tran	3693	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>15 December 2008</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1,3-10 and 13-20</u> is/are pending in the application.

    4a) Of the above claim(s) <u>13-20</u> is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1 and 3-10</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>13 April 2001</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12-15-

2008 has been entered.

Status of Claims

2.   This action is in reply to the amendment filed on 12-15-2008.

3.   Claims 1, 3-11, and 13-20 were previously restricted.

4.   Claims 1, 3-11 were elected.

5.   Claims 13-20 are withdrawn

6.   Claims 1 and 3-11 are currently pending and have been examined.

Priority

7.   Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e)

or under 35 U.S.C. 120, 121, or 365(c) is acknowledged.

Claim Rejections - 35 USC § 112

8.   Applicant's arguments, with respect to the previous rejections under 35 USC 112

have been fully considered and are persuasive. The previous rejections under 35 USC

112 have been withdrawn.

9.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

10.   Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite

for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention. The claim states, "reasons using status parameters in the

profile, the current location and the reference location." It is unclear how the location

information related to the status parameters in the profile. Further, it is unclear how

"reasons" is defines a step. For the purposes of this office action, the examiner

understands this limitation to mean "using status parameters in the profile."

Claim Rejections - 35 USC § 101

11.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the
> conditions and requirements of this title.

Claims 1 and 3-10 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter. Based on Supreme Court precedent, a proper

process must be tied to another statutory class or transform underlying subject matter to

a different state or thing (Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook,

437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane

v. Deener, 94 U.S. 780,787-88 (1876)). The independent claim states method steps

such as "receiving," "extracting," "retrieving," and "communicating." However this is not

sufficient to tie the process claim to a particular apparatus in another statutory class. To

qualify as a statutory process, the claim should positively recite the other statutory class

to which it is tied, for example by identifying the apparatus that accomplished the

method steps (In re Bilski, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008)).

Response to Arguments

12.   Applicant argues Hancock does not teach every element of claim 1. Applicant's

arguments with respect to claim 1 have been considered but are moot in view of the

new ground(s) of rejection.

13.   Applicant argues Hancock teaches away from the present invention. Applicant's

arguments have been fully considered but they are not persuasive. Hancock relates to

the instant invention in that he teaches customizing one or more environments based on

a location of a user.

14.   Applicant argues that Hancock does not teach configurable devices as claimed in

claim 10, Applicant's arguments have been fully considered but they are not persuasive.

Claim 10 includes a computer. Hancock teaches a client computer.

15.   Applicant argues that Hancock does not teach remotely setting a thermostat and

applicant repeatedly asserts that the instant application does not apply to computers.

However, in at least the summary of the invention and in claim 10 of the invention, the

invention is specifically described as being a computer. Applicant's arguments have

been fully considered but they are not persuasive. Hancock customizes the device by

delivering an enhanced, simplified, computing environment to the user based on the

location of the user terminal.

Claim Rejections - 35 USC § 103

16.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

17.   **Claims 1 and 3-10,** *as interpreted by the examiner,* are rejected under 35 U.S.C.

103(a) as being unpatentable over Nieminen et al, US Patent 6,578,075 in view of

Hancock et al., US Patent 6,202,023.

18.   **As per claim 1:**

Nieminen teaches a method for customizing one or more environments on a computer.

Specifically, Nieminen teaches:

- receiving, over a network, user identification for the user (see at least column 3

  line 28);

- retrieving a profile for the user, the profile including customization information for

  a plurality of customizable devices (see at least column 3 line 28-36); and

- communicating over the network with one or more of the customizable devices at the current location to customize the one or more customizable devices based on the customization information in the user's profile for the current terminal of the user (see at least column 3line 36-41).

He does not specifically teach that the location of the user further identifies the customization of the user terminal. However Hancock teaches further including location information to customize the user terminal. Specifically, Hancock teaches:

- receiving, over a network, location information for the user (see at least column 3 line 7-15)

- extracting a current location from the location information (see at least column 3 line 7-15);

- communicating over the network with one or more of the customizable devices at the current location to customize the one or more customizable devices based on a plurality of locations including the current location (see at least column 3line 23-36)

It would have been obvious to one of ordinary skill in the art at the time of the invention to customize an environment based on a stored user profile at the server station and a user's location with motivation to address the need of providing internet services to mobile users that are customized according to each user's geographical location, see at least Hancock, column 1 line 38-41.

17.   **As per claim 3:**

Nieminen further teaches:

- extracting a reference information from the profile (see at least column 3 line 24-44);

- generating a first list of environments to customize based on the reference information (see at least column 3 line 28-41); and

- retrieving a second list of the customizable devices corresponding to each of the environments in the first list (see at least column 3 line 28-41).

He does not teach that the profile information includes location information. However, Hancock further teaches that location information is included as information to send to the server and used to customize the environment, see at least column 1-3. Together, Nieminen in view of Hancock teach:

- extracting a reference location from the profile;

- generating a first list of environments to customize based on the reference location and the current location; and

- retrieving a second list of the customizable devices corresponding to each of the environments in the first list.

It would have been obvious to one of ordinary skill in the art at the time of the invention to customize an environment based on a stored user profile at the server station and a user's location with motivation to address the need of providing internet services to mobile users that are customized according to each user's geographical location, see at least Hancock, column 1 line 38-41.

18.   **As per claim 4:**

Nieminen further teaches wherein the step of generating a first list comprises:

- retrieving customization logic from the profile (see at least column 3 line 28-41);
  and

- executing the customization logic to generate the list of environments (see at
  least column 3 line 28-41).

19.   **As per claim 5:**

Nieminen further teaches wherein the customization logic comprises one or more of:

- *using status parameters in the profile* (see at least column 9 line 15-17).

Only one of the options are shown because the use of the word "or" in the preamble of

the claim. Thus, the following limitation is not particularly pointed out.

- customizing an environment listed in a table based on a difference between the
  current location and the reference location; and

20.   **As per claim 6:**

Nieminen further teaches wherein the generating the customization information

comprises:

- extracting from the profile customization commands (see at least column 9 line
  58 to column 10 line 4);

- retrieving configuration data from sources specified in the profile customization
  commands (see at least column 9 line 58 to column 10 line 4); and

- mapping the configuration data to customizable devices in the second list of each of the environments in the first list (see at least column 9 line 58 to column 10 line 4).

21. **As per claim 7:**

Nieminen further teaches wherein the specified sources comprise one or more of:

- a database of configuration data for particular customizable devices (see at least column 9 line 61-63).

Only one of the options are shown because the use of the word "or" in the preamble of the claim. Thus, the following limitation is not particularly pointed out.

- an already customized environment; and

22. **As per claim 8:**

Nieminen further teaches wherein the mapping step comprises:

- matching one or more portions of the configuration data with one or more customizable devices in the second list for each of the environments in the first list (see at least column 9 line 58 to column 10 line 4);
- collecting configuration data for each of the customizable devices in the second list of the environments in the first list (see at least column 9 line 58 to column 10 line 4); and
- integrating the collected configuration data for each of the customizable devices (see at least column 7 line 29-35).

23.   **As per claim 9:**

Nieminen further teaches wherein the customizing step comprises:

- identifying a network address for each of the customizable devices (see at least

  column 5 line 61-67); and

- setting, via the network, each of the customizable devices to operate in a manner

  consistent with corresponding integrated collected configuration data (see at

  least column 7 line 28-35).

24.   **As per claim 10:**

Nieminen further teaches wherein the customizable devices include one or more of

computers (see at least column 5 line 5-11)

Only one of the options are shown because the use of the word "or" in the preamble of

the claim. Thus, the following limitation is not particularly pointed out.

- communication devices, appliances, motor vehicles, temperature controls,

  entertainment devices, security devices, lights.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Thuan Tran whose telephone number is 571-270-1832.

The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thuan Tran
Patent Examiner
3-23-2009

/Stefanos Karmis/
Primary Examiner, Art Unit 3693